IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No. 3759
Szardenings *et al.*	Art Unit: 1654
Appl. No.: 09/674,733	Examiner: Chism, Billy D.
§371 Date: May 2, 2001	Atty. Docket: 1085.0050000/RWE/ALS
For: **Melancortin 1 Receptor Selective Compounds**	

Reply To Restriction Requirement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated October 2, 2003 (PTO Prosecution File Wrapper Paper No. 9), requesting an election of one invention to prosecute in the above-referenced patent application, Applicant hereby provisionally elects to prosecute the invention of Group I, represented by claims 1-24 and 27. Applicants note that the Examiner did not group claims 29 and 30, which appear to be a part of Group I. Hence, it is believed that Group I includes claims 1-24, 27, 29 and 30. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.

Applicants assert that this Restriction Requirement based on lack of unity of invention is unfounded. U.S. Patent and Trademark Office regulations provide guidance to Examiners in regard to unity of invention:

> (b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combination of categories: . . .
>
> (2) A product and process of use of said product; . . . .

37 C.F.R. § 1.475(b)(2).

Furthermore, the Administrative Instructions Under the PCT provide:

> (c) **Independent and Dependent Claims.** Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed for example, product, process, use or apparatus or means, etc.).
>
> (i) *If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.* Equally, no problem arises in the case of a genus/species situation where the genus claim avoids the prior art. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination claim avoids the prior art and the combination claim includes all the features of the subcombination.

Administrative Instructions Under the PCT, Annex B, Part I (emphasis added).

The following examples are also provided as guidance to Examiners:

Example 1

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X.

Example 17

Claim 1: Protein X.

Claim 2: DNA sequence encoding protein X.

> Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 and 2 is accepted.

Id. at Part 2.

Here, claims 1, 9 and 10 are the only independent claims and are all part of Group I. Because these claims are in the same group, it necessarily follows that all of their dependent claims have unity of invention and should be examined together. Hence, claims 1-64 possess unity of invention and must be examined together. Moreover, the claims of Groups I and II are related like claims 1 and 2 of Example 17 shown above. The remaining dependent claims are related like claims 2 and 3 of Example 1 provided above. Just as the claims in these examples possess unity of invention, Applicants' claims 1-64 possess unity of invention. Furthermore, the Restriction Requirement does not cite any art to support the allegation of lack of unity of invention. Thus, the Restriction Requirement is improper because unity of invention exists amongst the claims.

Moreover, Applicants note that the application was considered to have unity of invention during the international phase. Since a search and examination has already been carried out during the international phase, it would place absolutely no burden on the examiner to examine all of the present claims.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional

extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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